

US Serial No. 10/552655
Page 9 of 22

Remarks:

Amendments to the claims:

Claims 3, 5, 8, 10, 11, 13, 15, 18 and 19 are pending in this application. Claim 3 was amendment to corrected maintain consistency within claim 3 and to maintain antecedent basis for the feature "fragrance ingredient."

No new matter is added to the application by this Amendment

Regarding the rejection of claim 3 under 35 USC 102(b) as allegedly being anticipated by or, in the alternative, under 35 USC 103(a) as allegedly being obvious over US 2060733 to Karr Hunt et al. (hereinafter "Karr Hunt"); and the rejection of claim 5 under USC 103(a) as allegedly being obvious over Karr Hunt:

Applicants respectfully traverse the rejections of the foregoing claims in view of Karr Hunt.

Prior to discussing the relative merits of the Patent Office's rejection, Applicant points out that unpatentability based on "anticipation" type rejection under 35 USC 102(b) requires that the invention is not in fact new. See *Hoover Group, Inc. v. Custom Metalcraft, Inc.*, 66 F.3d 299, 302, 36 USPQ2d 1101, 1103 (Fed. Cir. 1995) ("lack of novelty (often called 'anticipation') requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee"). Anticipation requires that a *single reference* [emphasis added] describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art. See, *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

The principle of "inherency," in the law of anticipation, requires that any information missing from the reference would nonetheless be known to be present in the subject matter of the reference, when viewed by persons experienced in the field of the invention. However, "anticipation by inherent disclosure is appropriate only when the reference

US Serial No. 10/552655
Page 10 of 22

discloses prior art that must necessarily include the unstated limitation, [or the reference] cannot inherently anticipate the claims." *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1373 [62 USPQ2d 1865] (Fed. Cir. 2002); *Hitzeman v. Rutter*, 243 F.3d 1345, 1355 [58 USPQ2d 1161] (Fed. Cir. 2001) ("consistent with the law of anticipation, an inherent property must necessarily be present in the invention described by the count, and it must be so recognized by persons of ordinary skill in the art"); *In re Robertson*, 169 F.3d 743, 745 [49 USPQ2d 1949] (Fed. Cir. 1999) (that a feature in the prior art reference "could" operate as claimed does not establish inherency).

Thus when a claim limitation is not explicitly set forth in a reference, evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co.*, 948 F.2d at 1268. It is not sufficient if a material element or limitation is "merely probably or possibly present" in the prior art. *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 [63 USPQ2d 1597] (Fed. Cir. 2002). See also, *W.L. Gore v. Garlock, Inc.*, 721 F.2d at 1554 (Fed. Cir. 1983) (anticipation "cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in references"); *In re Oelrich*, 666 F.2d 578, 581 [212 USPQ 323] (CCPA 1982) (to anticipate, the asserted inherent function must be present in the prior art).

Additionally, the undersigned reminds the Examiner that the determination of obviousness under §103(a) requires consideration of the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1 [148 USPQ 459] (1966): (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of nonobviousness. More recently in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007), the Supreme Court held that The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated

US Serial No. 10/552655
Page 11 of 22

that "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. Exemplary rationales that may support a conclusion of obviousness include:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. See MPEP 2141 (III).

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

US Serial No. 10/552655
Page 12 of 22

A methodology for the analysis of obviousness was set out in *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000) A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher."

It must also be shown that one having ordinary skill in the art would reasonably have expected any proposed changes to a prior art reference would have been successful. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207, 18 USPQ2d 1016, 1022 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988); *In re Clinton*, 527 F.2d 1226, 1228, 188 USPQ 365, 367 (CCPA 1976). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

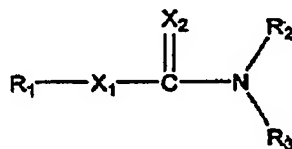
The Patent Office alleges that Karr Hunt teaches or suggests each and every feature of claim 3. Additionally, the Patent Office alleges that each and every feature of claim 5 would have been obvious to a skilled artisan at the time of the invention in view of Karr Hunt. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

Amended claim 3 requires a method of manufacturing a fragrance application, comprising the incorporation as fragrance ingredient of a tertiary non-vinyllic carbamate of formula (I), wherein the fragrance ingredient is a fragrance.

Claim 5 requires a compound of formula (I) wherein the compound is a fragrance.

US Serial No. 10/552655
Page 13 of 22

Karr Hunt does not teach or suggest the presently claimed method of manufacturing a fragrance application as recited in claim 3 because Karr Hunt discloses agents for the deterioration of cellulosic substances that are represented by the general formula



wherein $\text{X}_1, \text{X}_2 = \text{O}, \text{S}$ or

= hydrocarbon residue

$\text{R}_2, \text{R}_3 = \text{H}$, organic (especially hydrocarbon) radicals.

R_1, R_2 , and R_3 , for example, may be such general types of hydrocarbon radicals as alkyl, alkenyl, aryl, aralkyl, cycloalkyl, etc.

or such particular hydrocarbon radicals as methyl, ethyl, propyl, i-butyl, amyl, decyl, dodecyl, octadecyl, phenyl, tolyl, xylyl, naphthyl, benzyl, cinnamyl, 9,10-octadecenyl, cyclohexyl, naphthenyl, etc. (See page 1, col. 1, lines 1-5 and col. 2, lines 32-50)

Applicants submit that Karr Hunt's general formula is a very broad general formula and that the number of compounds (even if isomers are excluded) for Karr Hunt's general formula is indefinite because no limitations are given with regard to, for example, the number of carbon atoms. Applicants respectfully disagree with the Patent Office's allegation that the genus limits the moieties and thus the number of possible materials is finite.

The present claims are directed a subgenus of tertiary carbamates possessing an odor which makes the tertiary carbamates suitable as fragrance ingredients. Karr Hunt, at best, discloses only one single tertiary carbamate, namely, N-methyl-N-phenyl ethyl carbamate out of 27 other types carbamates; however, Karr Hunt do not even provide experimental data regarding the compound.

US Serial No. 10/552655
Page 14 of 22

Nowhere does Karr Hunt teach or suggest a method of manufacturing a fragrance application comprising the incorporation as fragrance ingredient of a tertiary non-vinyl carbamate of formula (I), wherein the fragrance composition is a fragrance as recited in claim 3. Moreover, Karr Hunt fails to teach or suggest a compound of formula (I) wherein the compound is a fragrance as recited in claim 5.

Karr Hunt fails to provide a skilled artisan with any motivation to select the presently claimed subgenus as a fragrance ingredient for a method of manufacturing a fragrance application. Applicants submit that a material which might be suitable as deterioration agent is not inherently a material possessing odor characteristics making it suitable as a fragrance ingredient. Based on the teachings of Karr Hunt, a skilled artisan would not have had a reasonable expectation that a subclass of Karr Hunt's compounds possess odor or fragrance properties making them suitable as a fragrance ingredient.

Because the features of independent claims 3 and 5 are not disclosed, taught or suggested by Karr Hunt, Karr Hunt cannot anticipate, nor would not have rendered obvious, the features specifically defined in claims 3 and 5.

For at least these reasons, claims 3 and 5 are patentably distinct from and/or non-obvious in view of Karr Hunt. Reconsideration and withdrawal of the rejections of the claims under 35 USC 102(b)/103(a) and 103(a) are respectfully requested.

Regarding the rejection of claims 3, 5, 8, 10, 11, 13, 15, 18 and 19 under 35 USC 103(a) as allegedly being unpatentable over US Patent Publication No. 2001/0036907 to Finch et al. (hereinafter "Finch") in view of Karr Hunt:

Applicants respectfully traverse the rejection of the foregoing claims in view of Finch and Karr Hunt.

The Patent Office alleges that each and every feature of the foregoing claims would have been obvious to a skilled artisan at the time of the invention in view of the teachings of

US Serial No. 10/552655
Page 15 of 22

Finch and Karr Hunt. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

Finich describes a laundry treatment composition comprising a water-soluble or water-dispersible rebuild agent for deposition onto a fabric during a treatment process wherein the material undergoes during the treatment process, a chemical change by which change the affinity of the material for the fabric is increased (see the Abstract).

Applicants agree with the Patent Office that Finch fails to teach or suggest the presently claimed carbamates. However, as discussed above with respect to the rejection that solely based on Karr Hunt, Applicants submit that Karr Hunt fails to remedy the deficiencies of Finch with respect to independent claims 3 and 5. A skilled artisan, armed with the teaching of Finch and Karr Hunt, would not have been motivated by either of those teachings to modify Finch's laundry treatment composition with Karr Hunt's cellulosic deterioration substances. However, even if the teachings of Finch would have been modified with the Karr Hunt's cellulosic deterioration substances as alleged by the Patent Office, the resulting combination would not have achieved the presently claimed method and compound.

Finich and Karr Hunt, taken singly or in combination, do not teach or suggest a method of manufacturing a fragrance application comprising the incorporation as fragrance ingredient of a tertiary non-vinylic carbamate of formula (I), wherein the fragrance ingredient is a fragrance as required by claim 3. Finich and Karr Hunt, taken singly or in combination, do not teach or suggest a compound of formula (I) wherein the compound is a fragrance as recited in claim 5.

Because the features of independent claims 3 and 5 are not disclosed by Finch and Karr Hunt, taken singly or in combination, these references would not have rendered obvious, the features specifically defined in claims 3 and 5, from which claims 8, 10, 13, 15, 18 and 19 depend.

US Serial No. 10/552655
Page 16 of 22

For at least these reasons, claims 3, 5, 8, 10, 11, 13, 15, 18 and 19 are non-obvious in view of Finch and Karr Hunt. Reconsideration and withdrawal of the rejection of the claims under 35 USC 103(a) are respectfully requested.

Regarding the rejection of claims 3 and 8 under 35 USC 103(a) as allegedly being unpatentable over US Patent No. 3,966,903 to Torii et al. (hereinafter "Torii") in view of US Patent No. 4,260,526 to Kaiser et al. (hereinafter "Kaiser"):

Applicants respectfully traverse the rejection of the foregoing claims in view of Torii and Kaiser.

The Patent Office alleges that each and every feature of claims 3 and 8 would have been obvious to a skilled artisan at the time of the invention in view of the teachings of Torii and Kaiser. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

Torii discloses hair-waving compositions comprising (A) sulfites or bisulfites as the primary waving agent and (B) at least one wave accelerating agent, e.g. alkyl carbamate of the formula $R_1R_2NCOOR_3$, wherein R_1 , R_2 , and R_3 each stand independently for H, CH_3 , C_2H_5 , or C_3H_7 , (see col. 2, lines 44 – 53). According to the above-identified definition, 64 ($4 \times 4 \times 4$) carbamates are disclosed, three of these 64 carbamates are given as an example, namely methyl carbamate, ethyl carbamate and ethyl N,N-dimethylcarbamate (see col. 3, lines 24 – 26). Only one carbamate, namely, ethyl carbamate was explicitly used. However, ethyl carbamate does not disclose a compound of formula (I) as recited in claim 3.

The only exemplified tertiary carbamate is ethyl N,N-dimethylcarbamate ($R^1 = R^2 =$ methyl (1 C atom); $R =$ ethyl (2 C atoms), thus $R^1 + R^2 + R = 4$ C atoms); however, this compound also fails to disclose a compound of formula (I).

US Serial No. 10/552655
Page 17 of 22

Applicants submit that the accelerating agents possess no unpleasant odor (see col. 3, line 32). However, Applicants respectfully disagree with the Examiner's interpretation that such disclosure indicates that the Torii's compounds are intended to be used as fragrance ingredient because Torii's compounds have a pleasant smell. Instead, Torii's compounds are used because they accelerate the waving process because Torii's compounds are accelerating agents. From Applicants' point of view, Torii, at best, only mentions that Torii's compounds do not possess unpleasant odor because the prior art waving compositions do possess an unpleasant odor (see col. 1, lines 40 – 42). There is nothing in Torii which explicit or inherently teaches that tertiary alkyl carbamates possess a pleasant odor.

Furthermore, Applicants want to point out that nowhere does Torii disclose that the accelerating agents could be combined with other material including perfumes. At best, Torii only mentions that Torii's compositions, namely a hair-waving compositions comprising (A) sulfites or bisulfites as the primary waving agent and (B) at least one wave accelerating agent, may be combined (see col. 4, lines 46–52).

Torii does not teach a method of manufacturing a fragrance application comprising the incorporation into the fragrance application as a fragrance ingredient a tertiary non-vinyl carbamate, wherein the fragrance ingredient is a fragrance. Kaiser fails to remedy the deficiencies of Torii because Kaiser also fails to teach a method of manufacturing a fragrance application comprising the incorporation into the fragrance application as a fragrance ingredient a tertiary non-vinyl carbamate, wherein the fragrance ingredient is a fragrance.

Regarding the combination of Torii with Kaiser, Applicants submit that the Patent Office's generalization of Kaiser's gamma-valerolactone is not admissible. Gamma-valerolactone belongs to a completely different class of molecules, namely lactones of Kaiser's general formula (III). Torii only teaches, at best, that certain compounds of

US Serial No. 10/552655
Page 18 of 22

different chemical classes possessing no unpleasant odor could be used as wave accelerating agent.

Torii combined with Kaiser does not teach that a fragrance material, in general, and a carbamate material, in general, are equivalents only because a compound listed does have these properties. If that were the case, that would mean that each fragrance ingredient would be suitable as wave accelerating agent, and that clearly can not be the case.

Accordingly, Torii and Kaiser, taken singly or in combination, fail to teach or suggest a method of manufacturing a fragrance application comprising the incorporation into the fragrance application as a fragrance ingredient a tertiary non-vinyl carbamate, wherein the fragrance ingredient is a fragrance as required by claim 3.

Because the features of independent claim 3 are not disclosed by Torii and Kaiser, taken singly or in combination, these references would not have rendered obvious the features specifically defined in claim 3 and dependent claim 8.

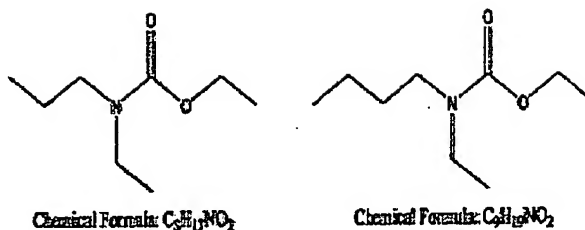
For at least these reasons, claims 3 and 8 are non-obvious in view of Torii and Kaiser. Reconsideration and withdrawal of the rejection of the claims under 35 USC 103(a) are respectfully requested.

Regarding the rejection of claims 11 and 13 under 35 USC 103(a) as allegedly being unpatentable over Torii:

Applicants respectfully traverse the rejection of the foregoing claim in view of Torii.

The Patent Office alleges that each and every feature of claims 11 and 13, which depend from claim 3, would have been obvious to a skilled artisan at the time of the invention in view of the teachings of Torii. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

US Serial No. 10/552655
Page 19 of 22



Applicants submit that the above-identified compound (R= ethyl; R^1 = ethyl, R^2 = butyl, 5th compound) may be regarded as a homolog or structural isomer of the genus as defined by Torii. However, Applicants submit that this is only relevant with respect to properties which are expected to be similar. And, as already discussed above, Torii clearly does not teach or suggest that Torii's compounds exhibit an odor nor would a skilled artisan expect Torii's compounds to exhibit an odor.

Moreover, Applicants would like to further point out that said compound is not explicitly disclosed in Torii and is, at best, only construed by the Patent Office.

Torii fails to teach or suggest a method of manufacturing a fragrance application comprising the incorporation into the fragrance application as a fragrance ingredient a tertiary non-vinyl carbamate, wherein the fragrance ingredient is a fragrance as required by claim 3, from which claims 11 and 13 depend.

Because the features of independent claim 3 are not taught or suggested by Torii, taken singly or in combination, Torii would not have rendered obvious the features specifically defined in dependent claims 11 and 13.

For at least these reasons, claims 11 and 13 are non-obvious in view of Torii.

Reconsideration and withdrawal of the rejection of the claims under 35 USC 103(a) are respectfully requested.

US Serial No. 10/552655
Page 20 of 22

Regarding the rejection of claims 8 and 15 under 35 USC 103(a) as allegedly being unpatentable over Karr Hunt in view of Torii and Kaiser:

Applicants respectfully traverse the rejection of the foregoing claim in view of Karr Hunt, Torii and Kaiser.

The Patent Office alleges that each and every feature of claims 8 and 15, which depend directly or indirectly from independent claim 3, would have been obvious to a skilled artisan at the time of the invention in view of the teachings of Karr Hunt, Torii and Kaiser. Applicants respectfully disagree with the allegations by the Patent Office as set forth in the Office Action.

Karr Hunt fails to teach or suggest the method specifically defined in claim 3, from which claims 8 and 15 directly or indirectly depend. Torii and Kaiser fail to remedy the deficiencies of Karr Hunt because Torii and Kaiser also fail to teach or suggest a method of manufacturing a fragrance application comprising the incorporation into the fragrance application as a fragrance ingredient a tertiary non-vinyl carbamate, wherein the fragrance ingredient is a fragrance.

Thus, Karr Hunt, Torii and Kaiser, taken singly or in combination, fail to teach or suggest a method of manufacturing a fragrance application comprising the incorporation into the fragrance application as a fragrance ingredient a tertiary non-vinyl carbamate, wherein the fragrance ingredient is a fragrance as recited in claim 3.

Because the features of independent claim 3 are not taught or suggested by Karr Hunt, Torii, and Kaiser, taken singly or in combination, these references would not have rendered obvious the features specifically defined in dependent claims 8 and 15.

For at least these reasons, claims 8 and 15 are non-obvious in view of Karr Hunt, Torii and Kaiser. Reconsideration and withdrawal of the rejection of the claims under 35 USC 103(a) are respectfully requested.

US Serial No. 10/552655
Page 21 of 22

Should the Examiner in charge of this application believe that telephonic communication with the undersigned would meaningfully advance the prosecution of this application, they are invited to call the undersigned at their earliest convenience.

The early issuance of a *Notice of Allowability* is solicited.

PETITION FOR A ONE-MONTH EXTENSION OF TIME

The applicant respectfully petitions for a one-month extension of time in order to permit for the timely entry of this response. The Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-1263 with respect to this Petition.

CONDITIONAL AUTHORIZATION FOR FEES

Should any further fee be required by the Commissioner in order to permit the timely entry of this paper, including but not limited to extension of time fees, the Commissioner is authorized to charge any such fee to Deposit Account No. 14-1263.

Respectfully Submitted;

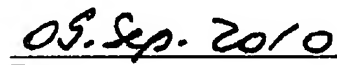

Andrew N. Parfomak, Esq.

Reg.No. 32,431

Norris, McLaughlin & Marcus P.A.

875 Third Avenue

New York, NY 10017


Date:

Tel: 212 808-0700

Enclosure – Request for Continued Examination